



UNITED STATES PATENT AND TRADEMARK OFFICE

JO
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,515	05/25/2005	Roger Salmon	70129	6467
26748	7590	10/22/2007	EXAMINER	
SYNGENTA CROP PROTECTION , INC. PATENT AND TRADEMARK DEPARTMENT 410 SWING ROAD GREENSBORO, NC 27409			SCHLIENTZ, NATHAN W.	
		ART UNIT	PAPER NUMBER	
		1616		
		MAIL DATE		DELIVERY MODE
		10/22/2007		PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/536,515	SALMON, ROGER
	Examiner Nathan W. Schlientz	Art Unit 1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 May 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-9 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/25/05, 10/30/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1-9 are pending and are examined herein on the merits for patentability.

No claim is allowed at this time.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claim 1 recites, "A compound for use as a plant fungicide of *the general formula (1)*". However, the terminology "the general" formula is indefinite, and thus the metes and bounds of the instant claims are not clearly defined.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

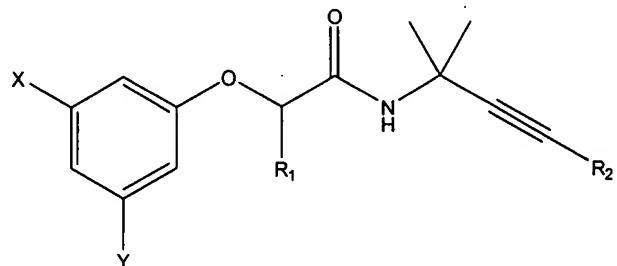
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

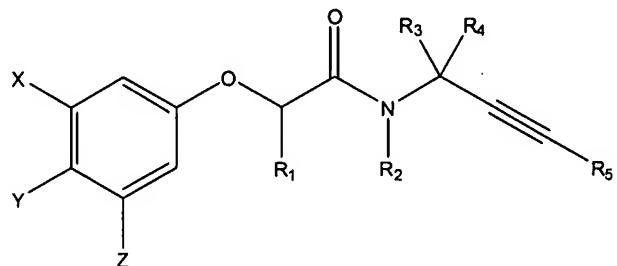
1. Claims 1-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 11-12 of copending Application No. 10/536,516 in view of U.S. Patent No. 4,146,387 (hereinafter Thiele).

Applicants claim a compound according to the formula:



Applicants also claim a composition comprising said compound, and a method of combating or controlling fungi by applying said compound.

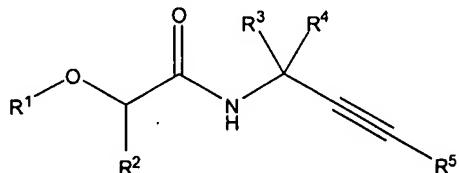
The '516 patent application claims a compound according to the formula:



The '516 patent application also claims a composition comprising said compound, and a method of combating or controlling fungi by applying said compound.

The X, Y, Z, R₁, R₂, R₃ and R₄ substituents of the '516 patent application claims overlap with the corresponding X, Y, and R₁ substituents of the instant claims. However, the R₂ substituents of the instant claims are limited to methyl or ethyl, whereas the R₅ substituents of the '516 patent application claims are optionally unsubstituted propyl or butyl or substituted C₁₋₄ alkyl, as well as other possible moieties. Therefore, the R₂ substituents of the instant claims is not exactly the same as the R₅ substituents of the '516 patent application claims.

However, Thiele disclose herbicidal compounds of the formula:



wherein R¹ is 3,5-dichlorophenyl or 3,5-dimethylphenyl, and R⁵ is C₁₋₄ alkyl, and the R², R³ and R⁴ substituents overlap with both the instant claims and the '515 patent application.

Therefore, it would have been *prima facie* obvious for one of ordinary skill in the art to use C₁₋₄ alkyl at the R² position of the instant claims and the R⁵ position of the '516 patent application claims because Thiele discloses compounds wherein the same position is C₁₋₄ alkyl, and the compounds are used for the same purposes as both the instant claims and the '516 patent application claims.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

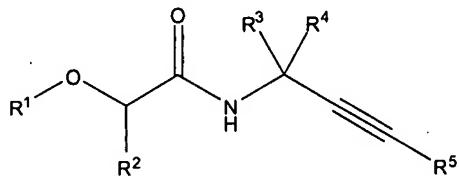
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Thiele.

Thiele discloses compounds of the formula:



in which

R¹ is substituted phenyl, with one to three substituents independently selected from the group consisting of Cl, Br, I, or C₁₋₄ alkyl, most preferably 3,5-dichlorophenyl or 3,5-dimethylphenyl;

R², R³, and R⁴ are independently C₁₋₄ alkyl, preferably independently selected from the group consisting of methyl and ethyl; and

R⁵ is H or C₁₋₄ alkyl, preferably H or methyl (column 1, lines 1-24 and 50-63; and claims 1-3 and 14-16).

Thiele further discloses the examples wherein R¹ is either 3,5-dichlorophenyl or 3,5-dimethylphenyl, i.e. N-(1,1-dimethyl-2-butynyl)-α-(3,5-dichlorophenoxy)butyramide and N-(1,1-dimethyl-2-butynyl)-α-(3,5-dimethylphenoxy)butyramide (column 2, lines 32-

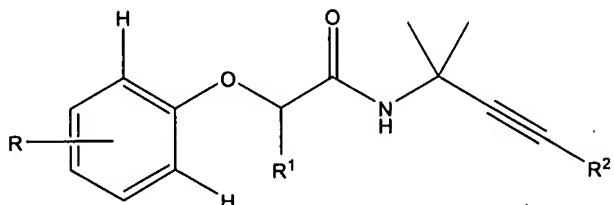
40). Thiele further discloses that said compounds are known herbicides (column 2, lines 32-33), and are incorporated into compositions (claims 1-3 and 5-10) used in a method for controlling undesired vegetation by applying said composition to the locus where control is desired (claims 14-16 and 18-23).

It is noted that Thiele does not explicitly disclose the composition being used to combat or control phytopathogenic fungi by applying said composition to a plant, to a seed of a plant, to the locus of the plant or seed or to soil or any other plant growth medium. However, Thiele does disclose a method for controlling undesired vegetation by applying said composition to the locus where control is desired (claims 14-16 and 18-23). The examiner respectfully points out the following from MPEP 2112: "The discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). In *In re Crish*, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004), the court stated that "just as the discovery of properties of a known material does not make it novel, the identification and characterization of a prior art material also does not make it novel." Therefore, the method of Thiele inherently combats or controls phytopathogenic fungi.

Art Unit: 1616

2. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,116,677 (hereinafter Walker '677).

Walker '677 discloses compounds of the formula:



in which

R is selected from the group consisting of trifluoromethyl, dimethyl, chloro, and dichloro, and preferably 3,5-dimethyl or 3,5-dichloro;

R¹ is methyl or ethyl, preferably ethyl; and

R² is methyl or ethyl, preferably methyl (column 1, lines 23-43; and claims 1-5).

Walker '677 also discloses the compounds N-(1,1-dimethyl-2-butynyl)-2-(3,5-dimethylphenoxy)butyramide, N-(1,1-dimethyl-2-butynyl)-2-(3,5-dichlorophenoxy)-butyramide, N-(1,1-dimethyl-2-pentynyl)-2-(3,5-dimethylphenoxy)butyramide, and N-(1,1-dimethyl-2-pentynyl)-2-(3,5-dichlorophenoxy)-butyramide (columns 4-6; and Table 1, Examples 1-2 and 5-6).

Walker '677 further discloses that the abovementioned compounds are effective herbicidal agents and teaches pre-emergence and post-emergence treatment of plants (columns 7-8; and claims 6-15).

It is noted that Walker '677 does not explicitly disclose the composition being used to combat or control phytopathogenic fungi by applying said composition to a plant, to a seed of a plant, to the locus of the plant or seed or to soil or any other plant

growth medium. However, Walker '677 does disclose a method of controlling undesired vegetation by applying said composition to the locus where control is desired (claims 14-16 and 18-23). The examiner respectfully points out the following from MPEP 2112: "The discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). In *In re Crish*, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004), the court stated that "just as the discovery of properties of a known material does not make it novel, the identification and characterization of a prior art material also does not make it novel." Therefore, the method of Walker '677 inherently combats or controls phytopathogenic fungi.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan W. Schlientz whose telephone number is 571-272-9924. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nathan W. Schlientz
Patent Examiner
Technology Center 1600
Group Art Unit 1616


SABIHA QAZI, PH.D
PRIMARY EXAMINER

Sabiha Qazi
Primary Patent Examiner
Technology Center 1600
Group Art Unit 1616